REMARKS

Reconsideration and allowance of this application are respectfully requested. Claims 4-5, 14-15, 24-25, 33-34 and 39 are cancelled. Claims 1-3, 6-13, 16-23, 26-32, 35-38 and 40-49 remain in this application and, as amended herein, are submitted for the Examiner's reconsideration.

Claim 1 has have been amended to place the application in condition for allowance. Because the changes merely repeat a limitation already recited in claim 1, no new issues that require further consideration or search are presented. It is therefore submitted that the present Amendment should be entered.

In the Office Action, the Examiner raised the following art rejections:

I.   Claims 1, 3, 11, 13, 21, 23, 31, 32, 37 and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn (U.S. Patent No. 5,721,829) in view of Abecassis (U.S. Patent Application Publication No. 2001/0041053), Sartain (U.S. Patent No. 5,914,712), Venkatraman (U.S. Patent No. 6,477,647), and Hylton (U.S. Patent No. 5,613,190). Applicant submits that the claims are patentably distinguishable over the cited references.

The Examiner acknowledges that the Dunn patent and the Abecassis publication "fail to disclose converting the user request into a distribution request e-mail message that includes the user request and [that] is addressed to [a] distribution controller of [a] transmitter". The Venkatraman patent, which describes an on-line trading system where the customer may opt to receive a confirmation e-mail message after completing a trade, and the Hylton patent, which is concerned with providing wireless distribution of video and wide band information services, also fail to disclose or suggest this feature.

The Examiner, however, contends that the Sartain

patent teaches a video-on-demand system wherein distribution requests are made via e-mail. Sartain describes a system in which:

> Internet connection 650 relays subscriber selections which are made over the internet. In the preferred embodiment, *an accounting service within the internet is provided* (1) through an internet company (e.g., America On-Line, CompuServe, and the like), (2) through an e-mail address, or (3) through a World Wide Web page. *This accounting service requests the selected video program identification number* along with a credit card number. The credit card number is used for the charge associated with the selecting of the video program. Thus, computers within the subscribers' homes can be used to order and display video programs. (Emphasis added).

(Col. 10, lines 15-20). Thus, Sartain describes that the subscriber selections of video programs are relayed over the Internet *to an accounting service* using, e.g., an e-mail address. The e-mail message is *addressed to the accounting service* rather than being addressed to the office that sends the selected programs to the subscriber's television. (See also Fig. 5).

The Examiner also asserts that the destination of the user requests, and thus the address of the e-mail request, is the external request gateway. However, Sartain further describes:

> Two-way set-top box information 630 can be provided *through IVR 600 and gateway 610 to office 330.* In this arrangement, a two-way set-top box is used in conjunction with a remote control in a subscriber's home. The remote control and prompts on the subscriber's television are used to select videos. The selection information is sent via RF signals to the company which provides the set-top box (e.g., a local cable company). *This selection information is then provided to the remote site associated with the selecting subscriber's group and to office 330 via gateway 610. Office 330 uses this information for tracking video selections, etc.* In an alternative embodiment, the selection information is sent by the

set-top box provider to office 330, and in turn, office 330 sends the selection information to the remote site associated with the selecting subscriber's group. (Emphasis added).

(Col. 9, line 60 - col. 10, line 7). The external request gateway does not provide the video programming. Rather, the external request gateway provides user supplied video selection and related information to the office which, in turn, delivers the video programming to the user. Thus, if the e-mail message is addressed to the external request gateway, it is *not addressed to a distribution controller of a transmitter.* (See also Fig. 5).

The Examiner also improperly argues that "there is no basis in asserting that an accounting service must inherently be remotely located and [a] separately managed entity from the office that provides the programming". However, the burden of factually supporting a *prima facie* conclusion of obviousness is on *the Examiner* and not on the applicant. M.P.E.P. § 2142. Thus, the burden is *on the Examiner* to show that the Sartain discloses or suggests a distribution request e-mail message that includes the user request and *that is addressed to a distribution controller of a transmitter.* The burden is not on the applicant to prove that the accounting service must inherently be remotely located and a separately managed entity from the office that provides the programming.

It follows that Sartain does not disclose or suggest a distribution request e-mail message *that is addressed to a distribution controller of a transmitter.*

Moreover, the Examiner contends that "one of ordinary skill in the art, when presented with the Dunn and Sartain disclosures, would clearly see that the headend disclosed by Dunn would provide the accounting service necessary for tracking and billing orders for providing video programming, and thus the

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e-mail request sent to said accounting service is addressed to the office which provides the video programming". However, Dunn is not concerned with such tracking and billing functions and merely describes that:

> Headend 22 provides both full length video content programs and associated previews (which are known as "trailers" in the film industry) to the user interface unit within each home. *Headend 22 includes a continuous media server (CMS) 40 with a program and trailer storage 42 to store the programs and previews as digital video data streams in independent data files.* Present designs of program and trailer storage 42 are expected to hold hundreds to thousands of full length programs and their trailers.
>
> ...
>
> *Headend 22 also has a database server 44 to store the programming information about each program and trailer.* Database server 44 contains a structured query language (SQL) database 46 with program data records containing information relating to available movies, games, TV shows, or other programs. The SQL records reflect such things as the program title, cast members, director, rating, whether the program has closed captioning or stereo audio, length of program, scheduled time of the program, network name, program category, description text, and so forth. *The program information is used by the VOD application and other applications running on the STB* (such as the electronic programming guide) to assist the viewer when previewing different programs.
>
> ...
>
> *A video content playing unit 48 is also provided at headend 22.* Video content playing unit 48 is connected to both the CMS database and the SQL database via headend bus 50. Video content playing unit 48 locates and retrieves a desired video content program from the CMS database in response to a request from an STB which is operating in the VOD mode. The playing unit further controls the digital transmission of the video content program over the distribution structure 30 on the VOD channel to the requesting STB. (Emphasis added).

(Col. 3, line 43 – col. 4, line 46). Dunn further describes that:

> The "order" button 86 enables the user to order a

> video content program that corresponds to the
> displayed analog preview video trailer, without
> reverting to a blank order menu or the like. Suppose
> the viewer wishes to rent the program that is
> presently being previewed. The viewer simply actuates
> the overlaid "order" button 86 *which causes the STB to*
> *send a message to the headend. This message contains*
> *some descriptor of the trailer (such as its ID or*
> *moniker) or some descriptor of the program (such as*
> *its ID or moniker) that corresponds to the trailer*
> *being depicted.* Such descriptors are initially
> supplied to the STB as part of an information packet
> obtained from the SQL database when the VOD
> application is initiated. *The descriptor is used by*
> *the CMS database to retrieve the full length video*
> *content program. The headend then transmits the full*
> *length video content program* as a digital video data
> stream over the distribution network to the STB that
> ordered the program. (Emphasis added).

(Col. 5, lines 24-41). Thus, Dunn merely teaches that the
headend stores information regarding the available stored video
programs and can retrieve and transmit requested video programs.
Dunn neither discloses nor suggests to the ordinary practitioner
that the headend carries out tracking and billing functions or
other accounting functions. In fact, the ordinary practitioner
could not readily glean from the teachings of Dunn whether such
tracking and billing functions are carried out by the headend
or, instead, are performed by the set-top box, such as in
combination with an accounting service disposed at a further
location.

Therefore, neither Dunn, Abecassis, Sartain,
Venkatraman, nor Hylton discloses or suggests:

> said receiver being operable to accept a user
> request for a desired program, the user request being
> in a free style text format, to convert the user
> request into a distribution request e-mail message
> that includes the user request and that is addressed
> to a distribution controller of said transmitter, and
> to send the distribution request e-mail message to
> said transmitter

as recited in claim 1.

For at least the same reasons, none the cited references discloses or suggests a distribution controller *that is operable to receive* a distribution request e-mail message *addressed to the distribution controller.*

Additionally, the Examiner relies on the Venkatraman Patent as teaching the transmission of confirmation e-mails to users. Venkatraman describes an on-line trading system where a customer connects to an on-line trading company (OTC) web site, enters an e-mail address where the customer is to receive trade confirmations, and then trades on-line. After the customer completes a trade, the OTC transmits an e-mail message to the customer that contains confirmation of the trade. (see Fig. 3; Col. 2, line 64 – Col. 3, line 3; and Col. 6, lines 8-23 and 39-54). The patent therefore describes an e-mail message that is sent *in response to a customer trade.* Venkatraman does not disclose or suggest transmitting an answer e-mail message *in response to a distribution request e-mail message.* The other cited references do not remedy the deficiency of Venkatraman.

Moreover, the Venkatraman patent cannot be considered analogous art. Venkatraman is directed to the field of *confirming trade transactions* (see Col. 1, lines 7-8) and is not concerned with *program distribution.* Thus, Venkatraman is in a different field of endeavor than that of the present application. Further, Venkatraman describes an e-mail message that *confirms a completed trade* rather than an e-mail message that is transmitted *as an answer to a request e-mail message.* Venkatraman is not reasonably pertinent to problem addressed by the program distribution system defined in claim 1. MPEP § 2141.01(a).

Therefore, none the cited references discloses or suggests:

said distribution controller being operable to
receive the distribution request e-mail message

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addressed to said distribution controller, to determine whether the requested program is one of the stored plurality of distributable programs, to transmit an answer e-mail message to said receiver in response to the distribution request e-mail message, the answer e-mail message including a notice of correspondence and including supplemental information when the requested program is one of the stored plurality of distributable programs, the supplemental information including cryptanalytic information for decrypting the program, and to read out the requested program from said distributable program storing unit when the requested program is one of the stored plurality of distributable programs,

as called for in claim 1.

It follows that neither Dunn, Abecassis, Sartain, Venkatraman, nor Hylton, whether taken alone or in combination, discloses or suggests the program distribution system called for in claim 1, and therefore claim 1 is patentably distinct and unobvious over the references.

Claim 3 depends from claim 1 and is distinguishable over the cited art for at least the same reason.

Claim 11 is directed to a method of distributing programs and includes limitations similar to those called for in claim 1.   Claim 11 is therefore patentably distinct and unobvious over Dunn, Abecassis and Sartain at least for the same reasons.

Claim 13 depends from claim 11 and is distinguishable over the cited references for at least the same reasons.

Claim 21 defines a transmitter and includes limitations similar to those recited in claim 11 and is also patentably distinct and unobvious over Dunn, Abecassis and Sartain for at least the same reasons.

Claim 23 depends from claim 21 and is distinguishable over the references at least for the same reasons.

Claim 31 is directed to a receiver having a controller that is operable in a manner similar to the receiver defined in

claim 1.   Therefore, claim 31 is patentably distinct and unobvious over Dunn, Abecassis and Sartain at least for the same reasons.

Claim 32 depends from claim 31 and at least for the same reasons, is distinguishable over the cited art.

Claim 37 is directed to a method of receiving programs and calls for converting an e-mail message into a distribution request having limitations similar to those described above. Therefore, at least for the same reasons, claim 37 is also patentably distinct and unobvious over Dunn, Abecassis and Sartain.

Claim 38 depends from claim 37, and for at least the same reasons, is distinguishable over the references.

II.   Claims 2, 6-8, 12, 16-18, 22, 26-28, 35 and 40 were rejected under 35 U.S.C. § 103 as being unpatentable over Dunn, Abecassis, Sartain, Venkatraman, and Hylton as applied to claims 1, 11 and 21 above and further in view of Yurt (U.S. Patent No. 5,550,863).   It is submitted, however, that the claims are patentably distinguishable over the references.

Claims 2 and 6-8 depend from claim 1, claims 12 and 16-18 depend from claim 11, claim 22 and 26-28 depend from claim 21, claim 35 depends from claim 31, and claim 40 depends from claim 37.   Therefore, each of claims 2, 6-8, 12, 16-18, 22, 26-28, 35 and 40 is distinguishable over Dunn, Abecassis, Sartain, Venkatraman, and Hylton at least for the same reasons.

The Yurt patent describes an audio and video transmission system in which a user accesses an item in a source material library by (i) dialing a system access number and then entering the identification code of the item or (ii) logging onto a user interface and then providing an identification code, a title or other known facts of the item.   (See Figs. 3 and 4; col. 11, lines 1-7; col. 13, lines 37-58; and col. 14, lines

34-51). Yurt does not remedy the above-described deficiencies of Dunn, Abecassis, Sartain, Venkatraman, and Hylton.

III. Claims 9, 19, 29, 36 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn, Abecassis, Sartain, Venkatraman and Hylton as applied to claims 1, 11, and 21 and further in view of Lawler (U.S. Patent No. 5,805,763). It is submitted, however, that the claims are patentably distinguishable over the cited references.

Claim 9 depends from claim 1, claim 19 depends from claim 11, claim 29 depends from claim 21, claim 36 depends from claim 31, and claim 41 depends from claim 37. Therefore, claims 9, 19, 29, 36 and 41 are each distinguishable over Dunn, Abecassis, Sartain, Venkatraman and Hylton at least for the reasons described above.

The Lawler patent describes an interactive viewing system in which a user selects programs for display or for future recording. The programs are selected from a menu that is generated by an interactive station controller located at the user's station and shown on a display screen. The selection of a program causes the interactive station controller to either tune to the program, set a reminder tag, or set a record tag that may be stored locally or sent to a headend. (See Figs. 2, 4A-4B, 6 and 7; col. 7, lines 19-28; col. 8, lines 12-17; col. 10, lines 30-64; col. 11, lines 7-31; and col. 11, line 45 - col. 13, line 12). Lawler does not remedy the deficiencies of Dunn, Abecassis, Sartain, Venkatraman and Hylton that are described above.

IV. Claims 10, 20, 30, 43, 45, and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn, Abecassis, Sartain, Venkatraman, Hylton, and Yurt as applied to claims 6, 16 and 26 and further in view of Lawler. However, it is submitted that the claims are patentably distinguishable over the cited art.

Claims 10 and 43 depend from claim 6, claims 20 and 45 depend from claim 16, and claims 30 and 47 depend from claim 26. Therefore, each of claims 10, 20, 30, 43, 45, and 47 are distinguishable over Dunn, Abecassis, Sartain, Venkatraman, Hylton, Yurt, and Lawler at least for the reasons described above.

V.   Claims 42, 44, 46, 48 and 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn, Abecassis, Sartain, Venkatraman, Hylton, and Lawler as applied to claims 9, 19, 29, 36 and 41 and further in view of Yurt.   However, Applicant submits that the claims are patentably distinguishable over the references.

Claim 42 depends from claim 9, claim 44 depends from claim 19, claim 46 depends from claim 29, claim 48 depends from claim 36, and claim 49 depends from claim 41.   Therefore, claims 42, 44, 46, 48 and 49 are each distinguishable over Dunn, Abecassis, Venkatraman, Hylton, Lawler, and Yurt for at least the reasons set out above.

Accordingly, the withdrawal of the rejections under 35 U.S.C. § 103 is respectfully requested.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.   If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that the Examiner telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which the Examiner might have.
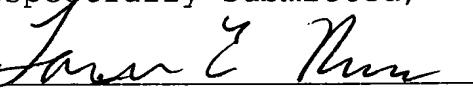
If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: January 19, 2006   Respectfully submitted,

By _____
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